

Hyun K. Kim, *et al.*
Application No.: 09/526,855
Page 16

PATENT

REMARKS

Upon entering the above amendment to claim 1 and adding new claims 61-65, claims 1-15, 17-40 and 42-65 will be pending in this application and are presented for examination. Claims 4, 9-23, 26-48 and 50-60 have been withdrawn from consideration by the Examiner. Claims 1-3, 5-8, 24, 25 and 49 stand rejected. Claim 16 is now canceled by Applicants without forfeiting any right to pursue canceled subject matter in a subsequent divisional or continuation application.

Claim 1 has been amended to claim the subject matter of the present invention with greater particularity.

New claims 61-65 have been added. Support for new claims 61-65 can be found with compounds 15, 38, 40, 41 and 46, see Examples 4, 9, 8, 7 and 10, respectively. Further support can be found in Figures 1 and 3, as well as the assay data in Table 1.

Applicants believe no new matter is present in this or any other portion of the present amendment.

Applicants express their gratitude to the Examiner for withdrawing the 35 U.S.C. § 102(b) rejection over Acosta *et al.* (*J. Chem. Soc., Chem. Commun.* 1994, 1985), as well as for withdrawing the 35 U.S.C. § 103(a) rejection over Peeters *et al.* (U.S. Patent No. 5,741,787).

Reconsideration of the application is respectfully requested in view of the above amendment to claim 1 and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. Provisional Obviousness-Type Double Patenting Rejection

The Examiner has provisionally rejected claims 1-3, 5-8, 24, 25 and 49 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-26 of copending U.S. Patent Application No. 09/180,132. Upon notification that

Hyun K. Kim, *et al.*
Application No.: 09/526,855
Page 17

PATENT

allowable subject matter is present in the instant application, Applicants will file the appropriate Terminal Disclaimer under 37 CFR § 1.321(c) to overcome the rejection.

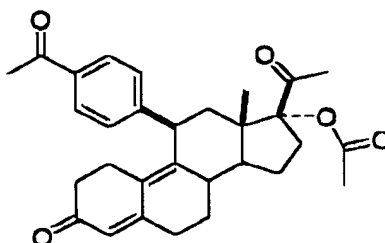
II. The Claims of the Present Invention are Not Anticipated by Cook *et al.*

The Examiner has maintained the 35 U.S.C. § 102(b) rejection of claims 1-3, 6-8 and 49 in view of Cook *et al.* (U.S. Patent No. 5,073,548). To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

Applicants note that the first proviso of claim 1 has been amended to recite the following:

if R^1 is $-C(O)CH_3$, $-N(CH_3)_2$ or $-NHCH_3$, R^2 is hydrogen, R^3 is acetyloxy and R^4 is methyl, then X is other than $=O$.

The acetyl functional group has been added to radical R^1 of the proviso in order to exclude compounds of Cook *et al.* With this amendment, the claims of the present invention do not encompass the cited compound of Cook *et al.*:



Accordingly, as the compounds of Cook *et al.* are not encompassed by the claims of the present invention, Applicants respectfully submit that the rejection has been rendered moot.

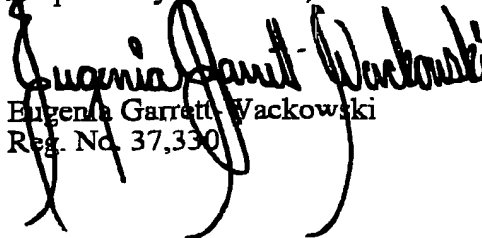
Hyun K. Kim, *et al.*
Application No.: 09/526,855
Page 18

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 925-472-5000.

Respectfully submitted,


Eugenia Garrett Wackowski
Reg. No. 37,330

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
EGW:lls
WC 9054607 v1